

Supreme Court of the United States

OCTOBER TERM—1942.

JACK SHILKRET,	No.
<i>Respondent,</i>	
AGAINST	
MUSICRAFT RECORDS, INC.,	
<i>Petitioner.</i>	

Brief in Support of Petition.

Opinions Below.

The opinion in the Circuit Court of Appeals for the Second Circuit was filed on December 9, 1942 (per Swan, *C. J.*, concurred in by Learned Hand, *C. J.*, Chase, *C. J.*, dissenting) (R. pp. 25-30), and is reported in 131 Fed. (2nd) 929. The opinion of the District Court was filed on December 10, 1941 (per Leibell, *D. J.*) (R. pp. 12-19), and is reported in 43 F. Supp. 184.

Statement.

The relevant facts and the grounds upon which jurisdiction is invoked are set forth in the petition.

Specification of Errors.

The errors which petitioner will urge if the writ of certiorari is allowed are that the Circuit Court erred:

1. In holding that mechanical reproduction rights are extended to the holder of a copyright registered under Section 11.
2. In holding that a work copyrighted under Section 11 has been published within the meaning of Section 1 (e) of the Copyright Act.
3. In holding that it was the intention of Congress that there be no distinction between published and unpublished works with regard to mechanical reproduction rights.

SUMMARY OF ARGUMENT.

POINT I.

The mechanical reproduction of unpublished compositions copyrighted under Section 11 does not constitute an infringement under the Copyright Act.

POINT II.

The copyright of a composition under section 11 does not constitute a publication thereof.

ARGUMENT.

POINT I.

The prevailing opinion of the Circuit Court in this case expressly recognizes that the Copyright Act of 1909 makes a definite distinction between published and unpublished works. Thus, at the outset, the Court states:

"The Copyright Act of 1909 recognizes a distinction between published and unpublished works of an author. Copyright of the former is obtained under §9, 17 U. S. C. A. §9, 'by publication thereof with the notice of copyright required by this title.' See *Washingtonian Co. v. Pearson*, 306 U. L. S. 30. Copyright of unpublished works, though not described by that term, is dealt with in Section 11, 17 U. S. C. A. §11. So far as now relevant, Section 11 reads as follows:

"Copyright may also be had of the works of an author, of which copies are not reproduced for sale, by the deposit, with claim of copyright, of one complete copy of such work if it be a * * * musical * * * composition; * * *. But the privilege of registration of copyright secured hereunder shall not exempt the copyright proprietor from the deposit of copies, under Sections 12 and 13 of this title, where the work is later reproduced in copies for sale" (R. p. 26).

It is conceded that the plaintiff in his complaint claimed a copyright under Section 11, that his work was unpublished, and that the allegations of infringement are confined to his alleged mechanical reproduction rights.

The sole provision in the Copyright Act for protection of mechanical reproduction rights is contained in Section 1, Subdivision (e) of the Copyright Act. It is there provided in part:

"Section 1. (Exclusive rights in copyrighted works.) That any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right: * * *

(e) To perform the copyrighted work publicly for profit if it be a musical composition; and for

the purpose of public performance for profit; and for the purposes set forth in subsection (a) hereof, to make any arrangement or setting of it or of the melody of it in any system of notation or any form of record in which the thought of an author may be recorded and from which it may be read or reproduced: *Provided, that the provisions of this title, so far as they secure copyright controlling the parts of instruments serving to reproduce mechanically the musical work, shall include only compositions published and copyrighted after July 1, 1909 * * *.*" (Italics the writer's.)

Section 1 (e) in extending copyright protection to mechanical reproductions thus expressly limits such protection to published compositions and no protection whatever is extended to holders of copyrights of unpublished works against alleged infringement by mechanical reproduction.

Prior to the enactment of the Copyright Act of 1909, the law as declared by the Supreme Court of the United States in *White-Smith Music Pub. Co. v. Apollo*, 209 U. S. 1, 52 L. Ed. 655 (1908), was that mechanical contrivances were not written or intelligible copies of a copyrighted work and therefore mechanical reproduction did not constitute an infringement.

The Copyright Act of 1909 by Section 1 (e) for the first time extended some protection to mechanical reproduction rights. But the protection given by Section 1 (e) is strictly limited to works which have been both published and copyrighted. Amdur, in his work on copyright law, substantiates this position. It is there stated:

"It would seem that mechanical reproduction rights apply only to musical compositions which have been published, since the Section states that the mechanical reproduction provisions of the Act

'shall include only compositions published and copyrighted after this Act goes into effect'." (Leon H. Amdur, Copyright Law and Practice, Clark Boardman Co., 1936 Ed., N. Y., p. 326.)

That the terms of Section 1 (e) would bar the plaintiff from recovery is recognized by the Circuit Court, which states:

"Read literally, the quoted phrase does seem to limit the right to compositions which are both published and copyrighted after July 1st" (R. p. 27).

In order to avoid the clear purport of the statute, however, the Circuit Court embarks on a journey into the nebulous fields of Congressional intent and concludes that when the legislature said "published and copyrighted" its terminology was "inept for copyrights of unpublished works" (R. p. 29) and that Congress meant not what it said, but what the Circuit Court believed it should have said.

Yet Judge Learned Hand, who concurred in the prevailing opinion, previously came to a contrary conclusion in deciding a similar question, holding that the court was not justified in construing the word "published" as equivalent to "copyrighted" even though that may have been a possible intent. In *Leibowitz v. Columbia Graphophone Co.*, 298 F. 342, involving the interpretation of Section 8 of the Act, Judge Hand said:

"The musical composition at bar has never been published at all; on the contrary, it was copyrighted as an unpublished work under Section 11. Literally, at least, the plaintiff does not fall within Section 8 (a) even if it applies to this kind of copyright at all. *I do not feel justified in extending the language 'at the time of the first publication'.* To

serve the plaintiff, it must be read as equivalent to 'at the time of acquiring the copyright.' Possibly that was the purpose, but the act recognizes expressly in Section 11 copyright in an unpublished work, so that the two are not synonymous.

It is always unsafe to attribute a given intent to Congress. Yet it may be that, as respects such copyrights, the benefits of the statute were extended to domiciled aliens only on condition of their reproducing copies for sale. Since it is publication which at common law defeats an author's common law literary rights, it is conceivable that it was thought proper to leave domiciled aliens who would not publish to such common law rights." (Italics the writer's.)

Similarly in the present case, the words "published and copyrighted" cannot be construed as equivalent to "copyrighted". To follow the reasoning of Judge Learned Hand, it may well be that as respects copyrights under Section 11, the benefits of the statute with respect to mechanical reproduction were to be extended only on condition that the copyright owner publish his work, and it was thought proper to leave copyright owners who would not publish to whatever common law rights they might have.

This interpretation is fortified by the Act itself. Section 2, which immediately follows Section 1 (e) provides that the rights of the owner of an unpublished work should not be annulled or limited by the provisions of the Copyright Act. Thus, Congress recognized that the owner of an unpublished work had certain rights different and distinguishable from those extended to the owner of a published work by the Copyright Act. Section 1 (e) in referring to mechanical reproduction rights has also set up certain arbitrary royalty payments and licensing provisions together with requirements with respect to filing

additional notices. These provisions with respect to mechanical reproduction rights have no counterpart in the Act. "Mechanical rights were treated as illegitimates, cared for by their natural parent—but never acknowledged" (Shafter, *Musical Copyright* 2nd Ed., p. 332).

In discussing the words "published and copyrighted" and the Congressional intent, the District Court said:

"To construe the proviso clause of Section 1, subd. (e) to conform to plaintiff's contention would require the elimination of the words 'published and' from the wording of the statute and leave only the word 'copyrighted'. The conjunction used is the word 'and', which connects the words 'published' and 'copyrighted'; it is not the word 'or' separating two alternatives. Of course, the proviso indicates clearly that it was not to be retroactive in its effect. It was intended that it 'should include only compositions published and copyrighted after the Act became effective on July 1, 1909.' *M. Witmark & Sons v. Standard Music Roll Co.*, 221 Fed. 376. See, also, 18 C. J. S., Sec. 118 (e). But that was not the sole purpose of the proviso, as I read it. It applied prospectively only to such musical compositions as were both published and copyrighted after July 1, 1909. If Congress had intended what plaintiff claims it did intend, the Congress would have used only the word 'copyrighted'" (R. pp. 18-19).

If courts can thus disagree as to a Congressional intent, then surely the express words of the statute should be permitted to govern. If the Circuit Court believed that it was desirable to extend mechanical reproduction rights to the holder of an unpublished copyright, then the remedy lies in amendment of the statute.

As this Court pointed out in *White-Smith Music Pub. Co. v. Apollo*, *supra*:

"Such considerations properly address themselves to the legislative and not the judicial branch of the government" (p. 18).

POINT II.

The copyright of a composition under Section 11 does not constitute a publication thereof.

To justify the conclusion that a composition copyrighted under Section 11 is given mechanical reproduction rights, the Circuit Court has been compelled to hold that a work copyrighted under that section has been "published". It is admitted that in order so to construe the word "we have to give it a meaning more limited than is ordinarily accorded it" (R. p. 29).

To say that a deposit of a copy of an unpublished work with the Copyright Office for registration under Section 11 constitutes a publication thereof leads to the absurd conclusion that an unpublished work intended to be copyrighted as such is transformed into a published work by the mere act of deposit. To state the proposition is to demonstrate its fallacy. If this contention be true, then the distinction in the Copyright Act and the Rules between published and unpublished works is completely nullified. There is then no necessity for the distinction between published and unpublished works set forth in Rule 19, nor for the provisions of Section 11 and Rule 23 providing for subsequent registration if the work is later published. The distinction between copyright under Sections 9, 12 and 13 on the one hand, and Section 11 on the other, is abrogated. The decision of the Circuit Court in this regard is contrary to a long line of decisions which have recognized the distinction between published and unpublished works. Thus in the case of *Patterson v. Century Productions Inc.*, 93 Fed. 2nd 489, the Court said:

“ * * * as the plaintiff did in the first instance comply with Section 11, his copyright so obtained was valid for an unpublished motion picture not a photoplay provided the work was unpublished. So long as it remained unpublished, he was not required to do more to keep his copyright valid for the statutory period.

But, if a work so copyrighted is later published, continued validity and the right to maintain a suit for infringement is dependent upon compliance with the statute and rules made under the authority of the statute applicable to the change in the status of the work which publication makes.”

Amdur in his *Copyright Law and Practice* states:

“Statutory copyright may be acquired in unpublished works, *i. e.*, of which copies are not reproduced for sale or distribution. There is, of course, no publication; copyright is secured by registration (and differs fundamentally from the copyrighting of published works, which is secured merely by publication with notice.) * * * ” (p. 439).

Shafter in his *Musical Copyright* states:

“Some composers may imagine that deposit with the copyright office is sufficient publication. This is not so. At the present time, some act of publication must exist in addition to the fact of deposit.”
(Shafter, *Musical Copyright*, 1939, 2d Ed., p. 94.)

The case of *Marks v. United States*, 96 Fed. 2nd 204 (C. C. A. 9) extensively cited by the Circuit Court in support of its conclusion involves the question whether the term of an unpublished copyright is limited. If the term

of this type of copyright were unlimited, the provisions with respect thereto would be unconstitutional in view of the constitutional provisions with respect to the limitation of the term of copyrights. The court stated the principle that legislative enactments must be construed if possible as constitutional and that the long acquiescence in the constitutionality of the copyright statute created a strong presumption in its favor. Although no definite term was fixed in the Act for unpublished copyrights, Section 60 of the Act provided that no manuscript of an unpublished work should be destroyed during its term of copyright without specific notice to the copyright owner. The Act therefore indicated "a declared purpose to limit all copyrights" (p. 206). The court therefore felt justified in supplying the omission in the Act by holding that the copyright should run twenty-eight years from the date of deposit. This is far from a holding that deposit is equivalent to publication or that the word "published" is equivalent to "copyright". If publication were equivalent to deposit, the extensive discussion in the *Marks* case with respect to constitutionality and intent of Congress would all have been unnecessary. It is submitted that the decision in the *Marks* case is no authority for the conclusion reached by the Circuit Court in this case.

In the cases of *Stern v. Remick*, 175 Fed. 282 (S. D. N. Y. 1910) and *Cardinal Films Corp. v. Beck et al.*, 248 Fed. 368 (S. D. N. Y. 1918), there are indications that a deposit of two copies of the work in the Library of Congress pursuant to Sections 9 and 12 constituted sufficient publication. These cases have no relevancy to the situation where the author is seeking a copyright for an unpublished work under Section 11. In any event, the authority of these cases has been questioned in the later case of *Joe Mittenthal Inc. v. Irving Berlin Inc.*, 291 Fed. 714 (S. D. N. Y. 1923). The court there stated (per L. Hand, *D. J.*):

"*Stern v. Remick* was rightfully decided because there had been a sale, but I must own that what I said there of publication seems to me now open to doubt" (p. 715).

The court also states that the *Cardinal Films Corp. v. Beck* case, *supra*, followed the ruling in the *Remick* case, and therefore, had no independent standing of its own. It may, therefore, be concluded that even under Sections 12 and 13 of the Act the deposit of two copies with the Copyright Office does not constitute a publication.

It is respectfully submitted that the Circuit Court erred in construing the Act to make a work copyrighted under Section 11 published within the purview of Section 1 (e). This decision to a great extent eradicates the difference between published and unpublished works in derogation of the very structure of the Act and the Rules, and it is contrary to and adds further confusion to previous decisions of the courts.

Conclusion.

For the reasons heretofore assigned, it is respectfully submitted that the case is one which justifies the issuance of a writ of certiorari.

Respectfully submitted,

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